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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,972	01/29/2004	Beat Huber	115514.01	2368
25944	7590	11/02/2004		
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320				
			EXAMINER STAICOVICI, STEFAN	
			ART UNIT 1732	PAPER NUMBER
DATE MAILED: 11/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/765,972	HUBER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Stefan Staicovici	1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 17-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/601,313.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/29/04</u> .   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-16, in the reply filed on 8/6/2004 is acknowledged. The traversal is on the ground(s) that the claims 17-36 of Group II have been amended to include the limitations of a first "injection molded part" and a second "injection molded part", thereby the restriction argument that "the product claims can be made by a materially different process" is moot. This is not found persuasive because, although the first and second parts are injection molded, the toothbrush can be made by a materially different process such as injection molding a first part and a second part and then adhesively bonding or mechanically fitting said injection molded first and second parts to form said toothbrush, wherein said first and second parts are made using materials having different thermal dilation coefficients. Further, it is noted that the invention of Group I is drawn to a process, whereas the invention of Group II is drawn to a product, hence the examination of both inventions requiring an examination in different classes and subclasses which places an undue burden on the Examiner.

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. Claims 1-2, 8-9 and 12-16 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 98/35809.

WO 98/35809 teaches the claimed process for making a composite toothbrush including, providing a first mold cavity having a first internal core within the cavity and distanced from the inner wall surface of the cavity, and having one or more internal members which extends between the inner wall and the core, forming the toothbrush body by injection molding of a plastics material having an internal body cavity within the grip handle corresponding substantially to the shape of the first core and having apertures passing through the body from the body cavity to the outer surface of the body corresponding substantially to the shape and position of the one or more internal member (recesses/projections); inserting a second internal core into the body cavity, between the second core and the inner surface of the body cavity there being at least one channel in communication with the apertures when the second core is in place in the body cavity; injecting a fluid moldable, settable material into the channels such that the material flows along the channels and into the apertures and then sets and separating the so-formed toothbrush body from the second mold cavity and the second core from the body cavity (see col. 6, lines 42-68 and, Figures 1, 3, and 4). It is noted that It is submitted that because the first material is a plastic material and the second material is an elastomer, then a chemical bond is not formed between said materials.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3-7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/35809 in view of Dair *et al.* (US Patent No. 6,076,223).

WO 98/35809 teaches the basic claimed process as described above.

Regarding claims 3-7, although WO 98/35809 teaches a plastic handle and an elastomeric covering, WO 98/35809 does not teach specific materials. Dair *et al.* ('223) teach a composite toothbrush including, a polypropylene handle and a transparent, styrene acrylonitrile covering (see col. 4, lines 50-65). Further, it is submitted that styrene acrylonitrile has a greater shrinkage coefficient than polypropylene. Furthermore, it is submitted that polypropylene is more resistant to cleaning agents. Therefore, it would have been obvious for one of ordinary skill in the art to have a polypropylene handle and a transparent, styrene acrylonitrile covering in the toothbrush made by the process of WO 98/35809 because, Dair *et al.* ('223) teach that such materials provides for an improved toothbrush and also because, WO 98/35809 teaches a toothbrush having a plastic handle and an elastomeric covering, hence requiring the materials of Dair *et al.* ('223) in order to function as described.

In regard to claims 10-11, Dair *et al.* ('223) teach a styrene acrylonitrile rubber (SAN), hence teaching a styrene and an acrylic nitrile co-polymer. It is submitted that polypropylene and

SAN do not form a chemical bond. Therefore, it would have been obvious for one of ordinary skill in the art to have a polypropylene handle and a transparent, SAN covering in the toothbrush made by the process of WO 98/35809 because, Dair *et al.* ('223) teach that such materials provides for an improved toothbrush and also because, WO 98/35809 teaches a toothbrush having a plastic handle and an elastomeric covering, hence requiring the materials of Dair *et al.* ('223) in order to function as described.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefan Staicovici, Ph.D. whose telephone number is (571) 272-1208. The examiner can normally be reached on Monday-Friday 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Colaianni, can be reached on (571) 272-1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Stefan Staicovici, PhD

A handwritten signature in black ink, appearing to read 'Stefan Staicovici', written in a cursive style.

Primary Examiner

10/30/04

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October 30, 2004